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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/727,622	12/01/2000	William Bricker Chamberlin III	3043	4179

7590 08/06/2004

THE LUBRIZOL CORPORATION  
Patent Department - Patent Administrator  
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EXAMINER

HUYNH, HAI H

ART UNIT PAPER NUMBER

3747

DATE MAILED: 08/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.



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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 09/727,622  
Filing Date: December 01, 2000  
Appellant(s): CHAMBERLIN ET AL.

**MAILED**  
**AUG - 6 2004**  
**GROUP 3700**

\_\_\_\_\_  
Neil A. DuChez  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed on May 26, 2004.

(1) ***Real Party in Interest***

A statement identifying the real party in interest is contained in the brief.

**(2) *Related Appeals and Interferences***

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

**(3) *Status of Claims***

The statement of the status of the claims contained in the brief is correct.

**(4) *Status of Amendments After Final***

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) *Summary of Invention***

The summary of invention contained in the brief is correct.

**(6) *Issues***

The appellant's statement of the issues in the brief is correct.

**(7) *Grouping of Claims***

Appellant's brief includes a statement that claims 1, 3-9 and 13-41 stand or fall together.

**(8) *Claims Appealed***

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(9) *Prior Art of Record***

5,456,222	Schechter	10-1995
5,834,407	Manka et al	11-1998

**(10) *Grounds of Rejection***

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1, 3-9 and 13-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schechter (5,456,222) in view of Manka et al (5,834,407).

Schechter teaches an electro-hydraulic camless valvetrain for an internal combustion engine. Schechter does not teach a lubricating oil composition that has low phosphorus or phosphorus-free. Manka et al teach a lubricating composition that has phosphorus content of up to about 0.08% by weight (see col. 28 line 54) for used in any engine (see col. 27 lines 8-31). Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to employ the lubricating composition that has low phosphorus on the

Art Unit: 3747

electro-hydraulic camless engine of Schechter as taught by Manka et al in order to improve the engine performance.

**(11) *Response to Argument***

The crux of Appellant's argument at pages 4-12 of the Appeal Brief is regarding the motivation to combine prior art references. Manka et al (5,834,407) suggest, "the lubricating compositions may be lubricating oils and greases useful in industrial applications and in automotive engines, transmissions and axles. These lubricating compositions are effective in a variety of applications including crankcase lubricating oils for spark-ignited, and compression-ignited internal combustion engines, including automobile and truck engines, two-cycle engines, aviation piston engines, marine and low-load diesel engines, and the like. Also, automatic transmission fluids, farm tractor fluids, transaxle lubricants, gear lubricants, metalworking lubricants, hydraulic fluids, and other lubricating oil and grease compositions can benefit from the incorporation of the compositions of this invention (see col. 27 lines 8-31)." Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to employ the lubricating compositions that has low phosphorus on the camless engine of Schechter as taught by Manka et al in order to reduce wear on the contacting surfaces of the engine components.

For the above reasons, it is believed that the rejections should be sustained.

Application/Control Number: 09/727,622  
Art Unit: 3747

Page 5

Respectfully submitted,



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HHH  
August 4, 2004

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